THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today as not written for publication in a law journal and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEVEN P. DEN BAARS,
ERIC J. TARSA, MICHAEL MACK,
BERND KELLER and
BRIAN THIBEAULT

Appeal No. 2005-0656
Application: 09/528,262

ON BRIEF

Before PAK, DELMENDO, and JEFFREY T. SMITH, Administrative Patent Judges.

PAK, Administrative Patent Judge.

REMAND TO THE EXAMINER

This case is not ripe for meaningful review and is, therefore, remanded to the examiner for appropriate action consistent with the views expressed below.

ISSUE I

At page 10 of the Answer, the examiner has set forth the following rejection:

> Claims 30, 31, 33-40, 54 and 55 are rejected under 35 U.S.C.[§]103(a) as being unpatentable over either JP '203 or alternatively JP '203/Kaneko as applied to the claims above, and further in view of McIntosh '309.

The initial inquiry into the propriety of the examiner's Section 103 rejection requires the determination of the scope of the claimed subject matter. *In re Paulsen*, 30 F.3d 1475, 1479, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994). Generally, we give the broadest reasonable interpretation to the terms in a claim taking into account the written description of the supporting specification. *In re Morris*, 127 F.3d 1048, 1054-55, 4 USPQ2d 1023, 1027 (Fed. Cir. 1997). When the terms in the claim are written in a "means-plus-function" format, however, we interpret them as being limited to the corresponding structure described in the specification and the equivalents thereof consistent with Section 112, sixth paragraph. *In re Donaldson Co.*, 16 F.3d 1189, 1193, 29 USPQ2d 1845, 1848 (Fed. Cir. 1994). According to *B. Braun Med., Inc. v. Abbott Labs.*, 124 F.3d 1419, 1424, 43 USPQ2d 1896, 1899 (Fed. Cir. 1997),

> structure disclosed in the specification is "corresponding" structure only if the specification or

> prosecution history clearly links or associates that structure to the function recited in the claim. This duty to link or associate structure to function is the *quid pro quo* for the convenience of employing § 112, ¶6.

In other words, the Federal Circuit demands that

> the corresponding structure(s) of a means-plus-function limitation . . . be disclosed in the written description in such a manner that one skilled in the art will know and understand what structure corresponds to the means limitation. Otherwise, one does not know what the claim means.

Here, both the examiner and the appellants have not adequately briefed us in determining the propriety of the examiner's Section 103 rejection. See the Brief, Reply Brief and Answer in their entirety. As is apparent from the record, the examiner and the appellants have disputed as to whether the applied prior art teaches or would have suggested the means-plus-function limitation "a means for selectively causing..." recited in independent claim 30. See, e.g., the Brief, page 23. However, it is not clear from the record what meaning, if any, is given to the claimed means-plus-function limitation by the examiner and the appellants and why the prior art structure, from the examiner's perspective, is identical to or suggestive of the corresponding structure described in the specification or equivalents thereof. *Id.*

ISSUE II

At page 7 of the Answer, the examiner has set forth the following rejection:

> Claims 4-7, 14, 15, 24, 41 and 42 are rejected under 35 U.S.C.[§]102(e) as being anticipated by Kaneko '901.

To establish a *prima facie* case of anticipation under Section 102, a single prior art reference must disclose, either expressly or under the principles of inherency, each and every element of a claimed invention. *In re Spada*, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990); *RCA Corp. v. Applied Digital Data Systems, Inc.*, 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). The examiner, however, has not addressed each and every limitation recited in independent claims 14, 41 and 42 in support of his or her Section 102 rejection. See the Answer, pages 7-8. Specifically, the examiner has not indicated where in Kaneko '901 the claimed pair of oppositely doped layers having particular characteristics can be found. *Id.* Thus, the examiner has not fully addressed the appellants' contention that Kaneko does not teach each and every limitation recited in independent claims 14, 41 and 42.

ORDER

Upon return of this application, the examiner is to determine

1) whether any structure described in the specification is "corresponding" to the means-plus-function limitation recited in claim 30 within the meaning of 35 U.S.C. § 112, second paragraph;

2) whether any corresponding structure, if present, in the specification is taught or suggested by the applied prior art (whether the examiner's Section 103 rejection in question is still applicable); and

3) whether Kaneko '901 teaches each and every limitation recited in claims 14, 41 and 42.

This determination necessarily requires the examiner to make reference to specification page numbers and/or lines in support of the examiner's interpretation of the claimed means-plus-function limitation and to prior art columns and lines, which provide bases for teaching or suggesting each and every claim limitation.

This remand to the examiner pursuant to 37 CFR § 41.50(a)(1) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)) is ***not*** made for further consideration of a rejection. Accordingly, 37 CFR § 41.50(a)(2) does not apply.

This application, by virtue of its "special" status, requires an immediate action, *MPEP* § 708.01(d). It is important that the Board be informed promptly of any action affecting the appeal in this case.

REMANDED

CHUNG K. PAK)
Administrative Patent Judge)
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ROMULO H. DELMENDO) BOARD OF PATENT
Administrative Patent Judge) APPEALS AND
) INTERFERENCES
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JEFFREY T. SMITH)
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